

Patent
09/745,846REMARKS

Claims 1-3, 5 and 25 are now pending in the application. Claims 26-28 have been canceled and Claims 1 and 25 have been amended. Claims 1 and 25 are the remaining independent pending claims.

Section 112, second paragraph rejection

Claim 25 was rejected under 35 USC 112, second paragraph, as indefinite, for having insufficient antecedent basis for the limitation "the computer readable medium" in line 7. Applicants have amended Claim 25 herein to now include the limitations of Claims 26-28 (now canceled), and has been further amended to recite "a compact disk" rather than the "computer readable medium". This is believed to address the issue as to antecedent basis. Reconsideration is requested.

Section 102(e) and 103(a) rejections

Claims 25-28 were rejected under 35 USC 102(e) as anticipated by US Patent 6,446,130 (Grapes) and Claims 1-3 and 5 were rejected under 35 USC 103(a) as being unpatentable over Grapes in view of US Patent 6,385,595 (Kolling et al.).

In view of the foregoing claim cancellations and amendments, and the following remarks, each of the rejections is respectfully traversed and reconsideration is requested.

Independent Claim 1, as amended herein, is directed to a method for preparing graphical content associated with corresponding digital audio content, including receiving the graphical content associated with the corresponding audio digital content from a digital database and preparing the graphical content for packaging with *a compact disk containing* the corresponding digital audio content by implementing at least one format conversion. The format conversion includes utilizing a first software program to manipulate the digital graphical content, creating postscript files corresponding to the digital graphical content, manipulating the postscript files corresponding to the graphical content utilizing a second software program, creating PDF files corresponding to the digital graphical content and printing the PDF files.

Patent
09/745,846

In the "Response to Amendment" section of the final Office Action, in response to Applicant's previous arguments that "Grapes does not teach or suggest printing the graphics file and attaching the printed graphics to the computer readable medium", the Examiner notes that he "could not find the word attaching or similar meaning in the specification" and that "nonetheless Grapes teaches a user requesting the presentation of a particular content package to be displayed to the proper reproduction devices located near the user....

Applicant respectfully submits that the recited "attaching the printed graphics to the computer readable medium" (recited in Claim 19 as originally filed), is described and supported in the specification, at least at paragraph [0016], reciting "following the conversion of the graphics file, the user can print out the related graphics...onto preformatted paper configured to replicate the various parts of the CD packaging being replicated...[and] once...printed on the preformatted paper, *the user simply folds ...and inserts the paper with the printed graphics into a blank CD case, thereby creating a replica of a retail outlet sourced CD*", and at paragraph [0092] further reciting that "to complete the *assembly of a digital audio recording and the corresponding printed graphic* that replicates that found in the conventional retail stream, a purchaser or user would need to further procure an appropriate container in which the audio media and the graphic media can be assembled *and combined to form a finished product*".

It is respectfully submitted that any permissible combination of the teachings of Grapes and Kolling fails to teach or suggest the method recited in each of amended independent Claims 1 and 25.

Again, Grapes is simply directed to a multimedia delivery system capable of "providing multiple streams of content to users...allowing users to interact with the system...providing information concerning the users to a centralized computer...providing users with the ability to perform financial transactions...and *provide a printed receipt or redemption coupon*" (Abst, emphasis added).

Grapes, as acknowledged by the Examiner, does *not teach or suggest* a method for preparing graphical content *associated with corresponding digital audio content*, including receiving the graphical content associated with the corresponding audio digital content from a

Patent
09/745,846

digital database and preparing the graphical content for packaging with a *compact disk containing the corresponding digital audio content* by implementing at least one format conversion – in which the format conversion includes (1) utilizing a first software program to manipulate the digital graphical content, (2) creating postscript files corresponding to the digital graphical content, (3) manipulating the postscript files corresponding to the graphical content utilizing a second software program, and (4) creating PDF files corresponding to the digital graphical content and printing the PDF files.

In order to clearly overcome the rejection based on Grapes and Kolling, each of the independent claims has been amended herein. Claim 1 recites the step of “preparing said graphical content for packaging with a compact disk containing said corresponding digital audio”. Claim 25 recites the steps of “storing the digital media file on a compact disk; and printing the graphics file and attaching the printed graphics to the compact disk”. Both Grapes and Kolling clearly fail to teach or suggest the methods recited in amended Claims 1 and 25.

In addition, Applicants again respectfully traverse the alleged “obvious” combination of the teachings of Grapes and Kolling in the manner suggested in the Action. There would be no teaching or suggestion, to one of ordinary skill in the art, to combine the teachings of Grapes and Kolling to modify Grapes “by employing commercially available software packages taught by Kolling for their ubiquitous use in desktop publishing and printable materials”. Rather, Grapes is very specifically directed to the “ability of advertisers to effectively target specific audiences and obtain direct consumer feedback regarding the effectiveness of their advertising” (col. 1, lines 26-28). One of ordinary skill in the art would have absolutely no motivation to combine the teachings of Grapes and Kolling in the manner proposed in the Action.

For at least the foregoing reasons, Applicants respectfully submit that amended independent Claims 1 and 25 are patentable over any permissible combination of the teachings of Grapes and Kolling and reconsideration is requested.

For at least the foregoing reason, Applicants respectfully submit that independent Claims 1 and 25, as amended herein, are not anticipated by Grapes, or rendered obvious by Grapes and Kolling and reconsideration is requested.

Patent
09/745,846

Dependent Claims 2, 3 and 5 are believed to be clearly patentable for all of the reasons indicated above with respect to Claim 1, from which they depend, and even further distinguish over the cited references by reciting additional distinguishing limitations.

It is respectfully submitted that in regard to the above remarks that the pending application is patentable over the art of record and reconsideration is accordingly requested. Should the Examiner be of the view that an interview would expedite consideration of this Amendment After Final Rejection or of the application at large, request is kindly made that the Examiner telephone Applicant's undersigned attorney at (908) 518-7700 in order that any outstanding issues may be resolved.

Respectfully submitted,

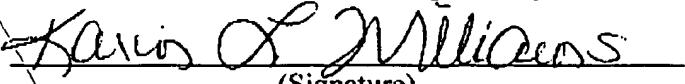


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